



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,603	11/15/2000	Adam Coyle		5258

20350 7590 09/24/2003

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/713603

Applicant(s)

Coyle

Examiner

Heers, 9

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 7/12/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-12, 14-19, 21-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-12, 14-19, 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. 09/713603.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3624

## **DETAILED ACTION**

### ***Response to Appeal Brief***

1. This action is issued in response to applicant's Appeal Brief(Paper #12) filed 7/12/03.
2. Prosecution is reopened.
3. Claims 1,3,5-12,14-19,21-23 are pending.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,3,5-12,14-19,21-23 are rejected under 35 USC 103(a) as unpatentable over Chaum(US Pat. No: 6,434,238) in view of Dorf(US Pat. No: 6,000,608) in view of Walker(US Pat. No: 6,338,049) and further in view of Novogod(US Pat. No:6,367,693).
6. As per claims 1,3,5-12,14-19, 21-23 Chaum teaches a stored value card system which comprises a card issuing institution(Abstract)(Fig 1/101) and a point of sale retail establishment(Fig 1/104). Chaum also teaches the card being useable for purchases(col 5 lines 10-40)and teaches reporting,managing and monitoring financial investments in an array of accounts(subaccounts) within a client asccount(Abstract)(Fig 1)(Fig 3-14)(col 3 line 6-col 5 line 59). Dorf teaches a card identifier associated with each card and assigned by the issuing

Art Unit: 3624

institution(col 4 line 36-col 5 line 14).Dorf teaches a reloadable smart card(col 5 lines 66-67).

Dorf further teaches an intelligent(smart) card(col 10 lines 49-64) which can be used as an online debit card with a sponsor bank(Fig 1/102) which can be used to transfer funds for any purpose including money orders. Dorf further teaches the use of loyalty cards which are not redeemable for cash(col 9 line 33-col 10 line 6).Dorf also teaches the card identifier being encoded on a magnetic strip(col 4 lines 36-46) and a (POS) reader terminal for the card(col 4 line 25-35) and which accept the card for transactions(col 4 lines 46-67) and engaging a sponsor bank with a master account through the central processor and the banking network which permits a merchant to add value(refunds) and loyalty points to a subaccount card(col 5 lines 4-14).Walker teaches a system for issuing traveler's checks(negotiable payment drafts)(col 2 lines 51-56) at a user's home or business(col 2 line 49-col 3 line 10) paid by credit card(Figs 1-6) and Novogod teaches a system for requesting and dispensing negotiable instruments(Abstract)(Fig 13-18)(col 2 line 11-col 3 line 45)(col 4 line 14-col 6 line 52). It would have been obvious to one skilled in the art at the time of the invention to combine Chaum in view of Dorf to teach the above. The motivation to combine is to teach a multifunction card system composed of a gift certificate card, a prepaid phone card, a loyalty card and a medical information card as enunciated by Dorf(col 3 lines 9-64).It also would have been obvious to one skilled in the art at the time of the invention to combine Chaum in view of Dorf in view of Walker to teach part of the disclosure. The motivation to combine is to teach a multifunction card system which may be used to obtain bearer negotiable payment draft traveler's checks at a user's home or business as enunciated by Walker(col 1 lines

Art Unit: 3624

41-53).It also would have been obvious to one skilled in the art at the time of the invention to combine Chaum in view of Dorf in view of Walker and further in view of Novogod to teach all of applicant's disclosure. The motivation to combine is to teach a multifunction card system which which enables a customer to request and dispense negotiable instruments(bank check's money orders and traveler's checks(Abstract)) through which a bank customer can request from one device that the negotiable instrument be printed and dispensed to another device as enunciated by Novogod(col 2 lines 6-10) and which may even be dispensed to someone other than the bank customer(col 6 lines 38-52) who may maintain a subaccount where the PIN may be selected by the principal(col 6 lines 48-52).

***Conclusion***

**7. THIS ACTION IS MADE NON-FINAL.**

The following reference not relied upon in the rejection is nevertheless considered relevant to applicant's invention and is entered as part of the record:

Veeneman(US Pat. No: 5,500,514) teaches an apparatus for generating negotiable gift certificates

\*\*\*\*\*

8. Questions concerning this communication should be specifically addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844.

GRA

  
September 20, 2003

DR. GEOFFREY R. AKERS, P.E.  
PRIMARY EXAMINER